

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Nicolson, et al.

Atty. Docket No.: 003707.00009

Patent No.: 6,951,894

Group Art Unit: 1714

Issued: October 4, 2005

Examiner: Edward Cain

For: Extended Wear Ophthalmic Lens

Confirmation No.: 6172

Request for Reconsideration of Denial in Part of Request for Certificate of Correction

Commissioner for Patents
Decisions & Certificates of Correction Branch
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request for reconsideration is responsive to the Office Communication dated February 2, 2006. The Office has set a four-week period for response making this response due on or before March 2, 2006.

Remarks begin on page 2 of this paper.

REMARKS

The Office Communication dated February 2, 2006, hereinafter "Communication," regarding a decision on Applicants' Request for Certificate of Correction has been received and carefully considered. The Applicants hereby request reconsideration of the Office's denial of certain requested corrections. Specifically, the Communication alleges that the requested changes to Col. 73, lines 62, Col. 73, lines 63 – 65, Col. 74, line 15, and Col. 77, lines 9 – 10 appear to broaden or otherwise amend the scope of claims 27, 28, 30 and 59, respectively, beyond mere formalities. As explained in more detail below, the Applicants respectfully traverse the grounds for denial as the requested corrections are claim amendments that were entered during prosecution of the patent but not reflected in the patent claims as issued.

Claim 27 (Previously Application Claim 185)

The Applicants requested "In column 73, line 62, please change "treatment is a" to -- treatment includes a--.". This amendment was presented in the Response and Amendment dated September 22, 2004, (See Attachment A, September 22, 2004 Response, page 9), as acknowledged by the Notice of Allowability dated March 24, 2005, (See Attachment B, Notice of Allowability dated March 24, 2005, page 4).

Claim 28 (Previously Application Claim 186)

The Applicants requested "In column 73, lines 63-65, please change "wherein said oxypem polymerizable material is a fluorine macromer and said ionopem polymerizable material" to --wherein said ionopem polymerizable material--." This amendment was also presented in the Response and Amendment dated September 22, 2004, (See Attachment A, September 22, 2004 Response, page 9), as acknowledged by the Notice of Allowability dated March 24, 2005, (See Attachment B, Notice of Allowability dated March 24, 2005, page 4).

Claim 30 (Previously Application Claim 188)

The Applicants requested "In column 74, line 16, please change "material comprises a fluorine macromer, and" to --material is formed from--." This correction is the result of two

amendments entered during prosecution. Specifically, an amendment to claim 30 in the Response and Amendment dated February 11, 2002 sets forth: "The extended lens of claim of 187, wherein said core polymeric material formed from [comprises a fluorine macromer, and] N-vinyl pyrrolidone." (See Attachment C, February 11, 2002 Response, page 13). The Applicants subsequently further amended the claim in the Response dated September 22, 2004 as follows: "The extended lens of claim of 187, wherein said core polymeric material is formed from N-vinyl pyrrolidone.", (See Attachment A, September 22, 2004 Response, page 10), as acknowledged by the Notice of Allowability dated March 24, 2005, (See Attachment B, Notice of Allowability dated March 24, 2005, page 4).

Claim 59 (Previously Application Claim 217)

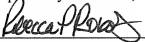
The Applicants requested "In column 77, lines 9 and 10, please change "54 including (c) said lens being autoclaved at predetermined temperatures." to "--54, said lens being sterilized." This correction is the result of two amendments submitted during prosecution. A first amendment was made to Claim 59 in the Response and Amendment dated Feb 11, 2002, which set forth: "The lens of claim 212, including © said lens being sterilized [at predetermined temperatures]". (See Attachment C, February 11, 2002 Response, page 15). The Applicants subsequently further amended the claim in the Supplemental Amendment dated February 26, 2002 as follows: "The lens of claim 212, including [©] said lens being sterilized", (See Attachment D, February 26, 2002 Supplemental Amendment, page 3), as acknowledged by the Office Action dated March 22, 2002, (See Attachment E, Office Action dated March 22, 2002, pages 1-2).

In view of the foregoing, the Applicants submit that all of the requested corrections identified in the Communication arise from amendments of record that were made during prosecution but not reflected in the claims of the patent as issued. Therefore, the Applicants respectfully request reconsideration and issuance of Applicants' October 19, 2005 Certificate of Correction in its entirety. Applicants submit herewith a copy of Form PTO/SB/44, in duplicate, as previously submitted on October 19, 2005.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below. Applicant believes there is no fee due in association with the filing of this response, however, should there be any fees due the Commissioner is hereby authorized to charge any such fees or credit any overpayment of fees to Deposit Account No. 19-0733.

Date: March 1, 2006

Respectfully submitted,

By: 
Rebecca P. Rokos
Registration No. 42,109
BANNER & WITCOFF, LTD.
10 South Wacker Drive, #3000
Chicago, IL 60606
Telephone: 312-463-5000
Facsimile: 312-463-5001